

In re Appln of Wolfram ANDERSCH et al
Appln No. 10/555,105
Reply to Office Action of Dec. 31, 2009
Amendment dated June 22, 2010

REMARKS

The Office Action mailed December 31, 2009, has been carefully studied. The claims in the application are now claims 13, 14, 2-5 and 8-12, with new main claim 13 corresponding to previous claim 6 being rewritten in independent form. Main claim 13 and the claims which depend thereon are specifically directed to those compounds exemplified which are shown to provide a synergistic effect. Applicants believe and respectfully submit that Applicants' claims define novel and unobvious subject matter under §§ 102 and 103, and therefore should be allowed. Favorable consideration and allowance are therefore respectfully urged.

Applicants first respectfully refer to a telephone conference between undersigned on behalf of Applicants and Examiner Packard on or about December 29, 2009, at which time the Examiner informed Applicants that although a new action was being prepared, the Examiner considered that there should be some allowable subject matter in the present application. This is further suggested in the Office Action in the middle paragraph on page 3, with reference to page 9 of Applicants' specification.

New claim 14 is added above, this claim being similar to but slightly narrower than claim 5. Claim 14, like claim 5, is patentable at least because it depends from and incorporates the subject matter of patentable main claim 13.

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Claims 1-6 and 8-12 have been again rejected as obvious from Watanabe in view of Cullen and Assmann. This rejection is respectfully traversed for the reasons of record, respectfully repeated by reference, and for the additional reasons set forth below.

The rejection states that Watanabe specifically teaches that the active compound may be used in a mixture of active components for the purpose of widening the activity spectrum and preventing the development of resistance. Where such effect occurs, a synergistic effect would be obvious, according to the rejection; and is said to be even suggested in the prior art (page 8, lines 23-28) where the ability of the combined active agents attack pests through a wider spectrum of activity than individual compounds. The rejection further contends that Assmann further supports this position by teaching the addition of multiple active compounds to pesticides are known to have synergistic effects. Thus the synergistic effect instantly claimed is not, according to the rejection, an unexpected result, given the teaching of the prior art which makes such a result expected. Applicants respectfully disagree.

Assmann states no more than what would be normally speculated, namely that a mixture of active agents may indeed (or may not) provide a synergistic effect. The skilled artisan does not know in advance whether or not any synergistic effect will occur with any mixture of active agents. Thus, the statement of Assmann that a mixture of active agents may provide a synergistic effect does not make the claimed invention obvious because the prior art does not provide any guidance as to which

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mixture of components, if any, would provide a synergistic effect.

Watanabe lists literally hundreds of pesticides of various types without disclosing any synergistic effects whatsoever, providing only the general statement (without any evidence) that synergistic effects may result. It is clear that such disclosure does not lead a person of ordinary skill in the art to arrive at the claimed invention. If the person of ordinary skill in the art were to learn anything from Watanabe as regards synergism, particularly in view of Assmann, it would be that synergism **might possibly occur** to produce synergistic effects in some of the mixtures; but to determine which mixtures would require thousands of tests. Again, this provides no real guidance to the person skilled in the art.

As Watanabe discloses that trifluorobutene is a nematocide, and as the only example (namely, use Example 1) shows activity as a nematocide, the person of ordinary skill in the art would be led in that direction, rather than trying any one of hundreds of other possible combinations. Based on the disclosure of Watanabe "as a whole" the person of ordinary skill in the art could not have reasonably expected any synergistic effect from any combination, even combinations with other nematocides, and certainly not with compositions of trifluorobutene with fungicides, bactericides, insecticides or acaricides.

In the paragraph spanning pages 3 and 4 of the Office Action, the PTO appears to attempt to use Applicants' disclosure against the Applicants. Respectfully, this is improper and unjustified. More particularly, the PTO contends that the

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Applicants' assertion of nearly infinite possible combinations is unfounded where the primary compound instantly claimed is the same primary compound taught in Watanabe and the variation only comes in selection of the secondary agent from specifically disclosed secondary components. The selection would then only require the selection of a secondary agent. The combination is not overly burdensome according to the rejection and the testing would simply require mixing the various compounds and resting with an expectation of success, where the result is a pesticide composition with a widened spectral of activity.

Applicants respectfully disagree! First, it should be clarified that the invention resides in providing a synergistic effect. Widening the spectral of activity does not necessarily lead to a synergistic effect. A widened utility per se is only an additive effect, not a synergistic effect.

The important point to be emphasized is that the prior art provides no guidance. It is like looking at the numbers on the dial of a safe. Yes, its true that all the numbers (in this case compounds) are mentioned, but the skilled artisan has no idea which of the compounds to select from among the many, many group 2 compounds listed in Watanabe which will result in any synergistic effect. The selection of any single compound from among Watanabe's group 2 compounds would provide no reasonable expectation of any synergistic effect.

Based on the Watanabe's disclosure, the person skilled in the art would understand that for providing an unexpected synergistic effect one has to select not only from the list of compounds disclosed in Watanabe, but in fact from all known pesticides since the list of pesticides has been provided in

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Watanabe only as examples of possibilities without any knowledge what compounds should be selected for providing synergy.

Withdrawal of the rejection is in order and is respectfully requested.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of Applicants' claims.

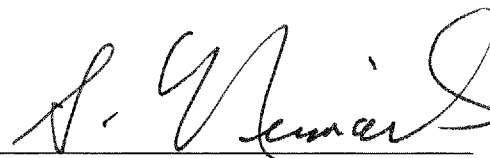
Applicants believe that all issues raised in the Office Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration, entry of the amendments above, and allowance are respectfully requested.

If the Examiner has any questions or suggestions, he is respectfully invited and requested to contact the undersigned at (202) 628-5197.

Respectfully submitted,

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